REMARKS

This application has been carefully reviewed in view of the above-referenced Office Action, and reconsideration is requested in view of the following remarks.

Request for Removal of the Finality of the Office Action

Applicant's prior arguments were evidently persuasive and have resulted in a new grounds for rejection. While amendments were made to all independent claims, the amendments merely explicitly call out that which was implicit in the claims as originally presented. Consider in particular claim 21. This claim originally called for "storing the encrypted selection of video content" and later "routing a selection of content". The amendment to this claim merely corrects the antecedent basis of selection ("a" changed to "the") and explicitly calls for "retrieving the stored encrypted selection of content" prior to "routing" it. Clearly, if it is routed, it has to first be retrieved. Accordingly, it is clear that Applicant's amendment did not necessitate the new grounds for rejection. In fact, the shortcomings of the original rejection resulted in the new grounds for rejection, rendering the finality improper. Hence Applicant requests that the finality of the current action be removed. Applicant appreciates that this is a matter suitable for petition, but prefers to first request removal of the finality of the Examiner.

Regarding the Rejections under 35 U.S.C. §103

All claims have been rejected as obvious by the combination of the Son reference of record in combination with the Candelore reference of record. Applicant respectfully traverses the rejections as follows:

The undersigned has reviewed the Son reference in detail and notes that the Son reference describes four <u>alternative</u> VOD cable distribution processes which he descriptively refers to as:

1)   "store, decrypt, and re-encrypt process" (col. 3, line 41);

2)   "decrypt, re-encrypt, and store process" (col. 4, line 28);

3)   "pass through process" (col 5, line 5); and

4)   "multiple-layer encryption process" (col 5, line 56).

Application No.: 10/764,202

The rejections presented in the Office Action are based extensively on quotations from the Abstract of Son, but the reference should be taken in its entirety for its teachings in considering the propriety of the rejection. Further, it should be noted the the multiple "aspects" described in the Abstract of Son are in fact multiple alternative embodiments, which appear in most if not all respects to be mutually exclusive. The Son reference relates to assuring security of the content being distributed at various points of concern. In particular, at the primary distribution network and the secondary distribution network of a cable network (see Background of the Invention). Applicant too is concerned with such security, but is further concerned with assuring interoperability of multiple encryption systems within the same network. Son fails to contemplate this issue at all.

The Candelore reference of record, which is commonly owned by the assignee of the present application, is concerned with interoperability of multiple encryption systems within the same network and presents at least one technique for providing such interoperability. As noted previously, in Candelore, content is stored in multiple selectively encrypted form (i.e., critical content is duplicated and encrypted under multiple encryption systems). Then, after determining compatibility of the STB placing the VOD order, the unneeded encrypted content is stripped away and the VOD content is transmitted in single selectively encrypted form.

The Office Action indicates that the combination of Son and Candelore renders the claims obvious "for the mere benefit of being able to provide increased security of video programming content for a multitude of different STB's using one or more encryption systems." The undersigned respectfully submits that this reasoning falls short of the requirements for properly combining the references to establish *prima* facie obviousness.

In accord with Graham v. John Deere, 383 U. S. 1 (1966), the Supreme Court set out a framework for applying the statutory language of §103 in making an objective analysis of obviousness. The Court stated that "under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give

light to the circumstances surrounding the origin of the subject matter sought to be patented." Id., at 17–18.

In accord with this analysis, in order to establish *prima facie* obviousness, it is the burden of the Office to identify each element of the claims in the prior art and further, to provide an explicit analysis as to the reasoning to support a conclusion of obviousness. (See In re Kahn, 441 F. 3d 977, 988 (CA Fed. 2006) - "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness"). In the present case, the present Office Action falls short of this requirement by failure to provide an adequate articulated reasoning as to why one of ordinary skill in the art would find it obvious to make the combination proposed to arrive at the claim limitations.

First, consider that the Son reference shows several techniques including 1) and 2) above in which content is encrypted, decrypted and then re-encrypted, but this is unrelated to providing services to multiple STBs with multiple decryption capabilities. The only purpose served is to assure security of the content at places of vulnerability. Candelore certainly addresses at least one method for delivery of content to multiple STBs having multiple decryption capability, but does so not by determining whether to pass through content as stored (in encrypted form) or by a decryption and re-encrytion process. Candelore does so by selective multiple encryption of the VOD content, followed by stripping one set of encrypted content from the selectively multiple encrypted VOD content. So, although this act takes place as a result of determining what type of STB and encryption is being used, the Office Action fails to provide any "articulated reasoning" for why one would encrypt, decrypt and re-encrypt in the manner taught and claimed.

In order to meet the claim features, for example of claim 1, one would have to not only use Son's alternative 1), but in addition, would appear to have to use contradictory alternative 3), and would have to base the selection of which alternative to use on the capabilities of the STB as taught by Candelore.

Moreover, it must be noted that the alternative 1) of Son provides for first encryption at a VOD source 402 of the content for transport via a primary distribution network to a remote server of 404 where it is stored. When the content is ordered, it is decrypted and then re-encrypted for

consumption by the recipient STB. (see col. 4, lines 36-59) In alternative 3) of Son, the VOD source 402 encrypts the content and sends it from the primary distribution network to the remote server 404. The same encrypted content is delivered to the recipient STB upon receipt of an order. (see col. 5, lines 1-50). There is no teaching, suggestion, motivation or articulated reasoning as to why one of ordinary skill in the art would find it obvious to combine these contradictory methods into one and select whether or not to decrypt or re-encrypt based upon the capabilities of the recipient STB. In this regard, both forms of encrypted content are already present in Candelore by virtue of the multiple selective encryption which he teaches. This is not the case in Son, where four apparently mutually exclusive alternatives are presented.

The Office Action reasons that the combination of Son and Candelore renders the claims obvious "for the mere benefit of being able to provide increased security of video programming content for a multitude of different STB's using one or more encryption systems." However, this reasoning fails to adequately explain why Son's apparently mutually exclusive encryption systems should be used together in combination with teachings from Candelore, whose only apparent relevance is determination of the capabilities of the recipient STB. The Office Action further fails to supply reasoning as to how one of ordinary skill in the art would find it obvious to use this determination to select among the mutually exclusive alternatives of Son, when the determination is used in Candelore merely to determine what information is unnecessary and can be deleted to conserve transport stream bandwidth. Clearly *prima facie* obviousness has not been established. Reconsideration and allowance of all claims are respectfully requested.

Applicant further reiterates that that Candelore teaches away from the method claimed by Applicant by providing a method that requires no decryption and re-encryption on demand by a user of the second decryption system. This teaching away has not been accounted for in providing any articulated reasoning for the combination.

In view of the above, claim 1 is believed clearly not obviated by the proposed combination. Reconsideration and allowance are respectfully requested.

All claims dependent upon claim 1 are also clearly not obvious for at least the reasons noted above. Hence, reconsideration and allowance are respectfully requested.

All other independent and dependent claims are clearly not obviated for the same reasons presented above. Hence, reconsideration and allowance of all claims are respectfully requested.

Specifically regarding claim 20, the reasoning of the Office Action clearly fails to adequately establish the obviousness of this claim. If the undersigned understands correctly, the Office Action reasons and asserts that Candelore and Son teach a computer readable storage medium and that the process can be carried out on a computer – and thus "there must also be an associated billing system database". However, nowhere can the undersigned identify any teachings of use of the contents of a billing system database to determine capabilities of a STB in order to implement the claimed function including all of the claim's features. The undersigned finds this reasoning to be astounding and unjustifiable, clearly falling far short of that required to satisfy the need for an "articulated reasoning" to account for missing claim features. Reconsideration and allowance is clearly in order and respectfully requested.

Concluding Remarks

The undersigned additionally notes that many other distinctions exist between the cited art and the claims. Since the rejection of the independent claims are clearly defective for the reasons noted above, there is not need to address the dependent claims at this time. Failure to address each point raised in the Office Action should accordingly not be viewed as accession to the Examiner's position or an admission of any sort; and, Applicant reserves the right to further argue the remaining claims individually should the need arise in future prosecution.

New claim 24 is submitted for the Examiner's consideration. Entry of this new claim is believed proper in view of the premature Final Rejection.

Interview Request

In view of this communication, all claims are now believed to be in condition for allowance and such is respectfully requested at an early date. If further matters remain to be resolved, the undersigned respectfully requests the courtesy of an interview. The undersigned can be reached at the telephone number below.

Application No.: 10/764,202

Respectfully submitted,

/Jerry A. Miller 30779/

Jerry A. Miller
Registration No. 30,779

Dated: 5/2/2008

Please Send Correspondence to:
Jerry A. Miller
Miller Patent Services
2500 Dockery Lane
Raleigh, NC 27606
Phone: (919) 816-9981
Fax: (919) 816-9982
Customer Number 24337

Application No.: 10/764,202

-14-